

Attorney Docket No. 7175-67612
Application No. 09/743,737 (Filed January 16, 2001)
Reply to Office Action dated September 8, 2005

REMARKS

Claims 32-35 and 45-90 remain in this application. Claims 45, 46, 49-53, 55, 57, 58, 60-62, 64, 66, 67, 69-73, 75-78, and 80-85 are amended. Claims 1-31 and 36-44 are canceled without prejudice or disclaimer of the subject matter therein. New claims 87-90 are added.

The examiner has indicated that claim 32 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. We note that claim 32 is already in independent form. However, upon further review, it appears that the allowable claim 32 in the subject application might possibly have the same scope as claim 31 in the U.S. Pat. No. 6,458,109 based on the parent application, Ser. No. 09/369,113. We invite the examiner to make his own comparison of the two claims. We also note that claims 32-34, which were withdrawn in the parent application, appear to be inadvertently published in the issued '109 patent.

Claim 86 has been listed as pending in Box 4 of PTO-326. However, in the body of the subject office action, the examiner has not indicated whether claim 86 is rejected or allowed. The examiner is, therefore, requested in the next office action, to explain the basis of rejection, if one exists, for claim 86. Since claim 86 has not yet been acted on, it would be improper for the examiner to make the next office action final.

In addition to claim 32, the examiner has indicated that claim 46, 47, 54, 65, 67, 68, and 74 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, we note that claims 54, 65, and 74 are already in independent form. Claims 46 and 67 are rewritten in independent form without narrowing their scope, and are believed to be allowable. Claims 47 and 68 depend from claims 46 and 67, respectively, and are therefore also believed to be allowable.

Reconsideration of the rejection of claims 76 and 84 under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,060,662 to Farnsworth, III ("Farnsworth") is requested. It is believed that amended independent claim 76, and dependent claim 84, are not anticipated by Farnsworth for the reasons given below.

Regarding claim 76, Farnsworth does not disclose or suggest a bandage "comprising a first sheet overlying a wound and located adjacent to it and a top sheet overlying the first sheet" in combination with "the first sheet having a plurality of discrete apertures overlying the wound." In contrast, as pointed out by the examiner, Farnsworth teaches an "open

air bandage” comprising “a sheet (16) with a plurality of discrete apertures (17).” Farnsworth does not disclose or suggest “a top sheet overlying the first sheet.” Accordingly, applicants respectfully submit that amended independent claim 76, and dependent claim 84, are not anticipated by Farnsworth, and hence withdrawal of the 35 U.S.C. 102(b) rejection thereof is respectfully requested.

Reconsideration of the rejection of claim 33 as being unpatentable under 35 U.S.C. 103(a) over U.S. Pat. No. 6,398,767 to Fleischmann (“Fleischmann”) is requested. It is believed that claim 33 patentably distinguishes over Fleischmann.

Regarding claim 33, the examiner acknowledges that “Fleischmann fails to teach a second drainage receptacle and a second drainage valve.” However, the examiner argues that it is “obvious to modify Fleischmann with the addition of the second drainage receptacle and a second drainage valve.” The examiner asserts that “it has been held that duplicating components of a prior art device is a design consideration within the level of ordinary skill in the art.” In support of his assertion, the examiner cites *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).” The examiner gives no explanation whatsoever of why it is obvious to modify Fleischmann in the manner indicated by him. If Fleischmann needed additional drainage capacity, he would have made his drainage receptacle 28 larger. Providing “a second drainage receptacle and a second drainage valve” in Fleischmann, as proposed by the examiner, seems counterintuitive. Absent the hindsight afforded by the applicants’ disclosure, it would not be obvious to a person of ordinary skill in the art to “modify Fleischmann with the addition of the second drainage receptacle and a second drainage valve.”

The examiner’s reliance on Harza is the type of application of “a per se obviousness rule” that the Federal Circuit Court appears to have prohibited in *In re Ochai*, 37 USPQ2d 1127 (1995). In re Ochai, the Federal Circuit Court has stated that “reliance on *per se* rules of obviousness is legally incorrect and must cease.”

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. **But reliance on *per se* rules of obviousness is legally incorrect and must cease.** Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of

obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction.
(Highlighting provided.)

Accordingly, applicants respectfully submit that claim 33 patentably distinguishes over Fleischmann, and hence withdrawal of this 35 U.S.C. 103(a) rejection thereof is requested.

Reconsideration of the rejection of claims 33, 34, 45, 49-53, 55-57, 60-62, 64, 66, 69-73, 75-77, 80-83, and 85 as being unpatentable under 35 U.S.C. 103(a) over GB Pat. No. 1,549,756 to Westaby et al. (“Westaby”) in view of Fleischmann is requested. It is believed that independent claims 33, 45, 55, 66, and 76, and dependent claims 34, 49-53, 56, 57, 60-62, 64, 66, 69-73, 75-77, 80-83, and 85, patentably distinguish over Westaby and Fleischmann for the reasons given below.

Regarding claims 33 and 34, the examiner acknowledges that “Westaby et al. fail to teach first and second fluid drainage receptacles coupled to the drainage tube and first second valves coupled between the fluid drainage tube and first and second fluid drainage receptacles, respectively.” However, the examiner notes that Fleischmann discloses a first drainage receptacle (28) coupled to a drainage tube (16) and a first valve (34) coupled between the drainage tube (16) and the drainage receptacle (28), and argues that “it would have been obvious to one having ordinary skill in the art to modify Fleischmann with the addition of a second drainage receptacle and a second drainage valve.” The examiner further asserts that, “[i]n view of the modified device of Fleischmann, it would have been obvious to one of ordinary skill in the art to modify Westaby et al. by adding” first and second fluid drainage receptacles coupled to the drainage tube and first second valves coupled between the fluid drainage tube and first and second fluid drainage receptacles, respectively. The examiner gives no explanation whatsoever of why it is obvious to modify Fleischmann in the manner indicated by him and then combine Westaby with modified Fleischmann. As indicated above, absent the hindsight afforded by the applicants’ disclosure, it would not be obvious to a person of ordinary skill in the art to “modify Fleischmann with the addition of the second drainage receptacle and a second drainage valve” and then, in addition, combine Westaby with modified Fleischmann. Also, the examiner’s reliance on Harza is the type of application of “a per se obviousness rule” that the Federal Circuit Court appears to have prohibited in *In re Ochai*. Accordingly, claims 33 and 34 patentably distinguish over Westaby and Fleischmann, and hence withdrawal of this 35 U.S.C. 103(a) rejection thereof is requested.

Regarding claims 45, 55, 66, and 76, the examiner asserts that Westaby discloses “a flexible, transparent cover/sheet having a plurality of apertures/passageways (20, 22) through which fluid may be added to or removed from a wound.” However, Westaby does not disclose

or suggest a bandage comprising a sheet “having a plurality of discrete passageways overlying the wound” as required by claims 45, 66, and “having a plurality of discrete apertures overlying the wound” as required by claims 55, 76. As shown in Fig. 1, Westaby’s passageways 20, 22 do not “overly” the wound. Instead, as disclosed on page 2, lines 53-55, Westaby’s passageways 20, 22 are formed outside the wound area.

Fleischmann is not cited for, nor does it overcome the foregoing deficiencies of Westaby. Thus, Fleischmann does not disclose or suggest a bandage comprising a sheet “having a plurality of discrete passageways overlying the wound” as required by claims 45, 66, and “having a plurality of discrete apertures overlying the wound” as required by claims 55, 76. Instead, as shown in Figs. 1 and 2, Fleischmann discloses a foam pad (12) in which a drainage tube (16) is inserted. Not only Fleischmann does not disclose or suggest a “sheet,” but Fleischmann’s foam pad (12) does not have a plurality of “discrete passageways overlying the wound” as required by claims 45, 66 or “discrete apertures overlying the wound” as required by claims 55, 76. Accordingly, applicants respectfully submit that amended independent claims 45, 55, 66, and 76, and dependent claims 49-53, 56, 57, 60-62, 64, 66, 69-73, 75-77, 80-83, and 85, patentably distinguish over Westaby and Fleischmann, and hence withdrawal of this 35 U.S.C. 103(a) rejection thereof is requested.

Reconsideration of the rejection of claim 35 as being unpatentable under 35 U.S.C. 103(a) over Fleischmann in view of U.S. Pat. No. 5,690,815 to Krasnoff et al. (“Krasnoff”) is requested. It is believed that claim 35 patentably distinguish over Fleischmann in view of Krasnoff for the reasons given below.

Claim 35 depends from claim 33. Claim 33 is patentably distinguishable over Fleischmann for the reasons given above. Krasnoff is not cited for, nor does it overcome the foregoing deficiencies of Fleischmann. Thus, Krasnoff does not disclose or suggest “a bandage including a wound facing surface configured to face toward a wound and a fluid drainage passageway having an opening adjacent the wound facing surface” in combination with “a fluid drainage tube coupled to the fluid drainage passageway.” Also, Krasnoff does not disclose or suggest “first and second fluid drainage receptacles coupled to the drainage tube” in combination with “first and second valves coupled between the fluid drainage tube and the first and second fluid drainage receptacles, respectively.” Accordingly, applicants respectfully submit that claim 35 patentably distinguishes over Fleischmann and Krasnoff, and hence withdrawal of this 35 U.S.C. 103(a) rejection thereof is requested.

Reconsideration of the rejection of claims 48 and 63 as being unpatentable under 35 U.S.C. 103(a) over Westaby and Fleischmann in view of U.S. Pat. No. 6,142,982 to Hunt et

al. (“Hunt”) is requested. It is believed that claims 48 and 63 patentably distinguish over Westaby, Fleischmann and Hunt for the reasons given below.

Claim 48 depends from claim 45. Claim 45 is patentably distinguishable over Westaby and Fleischmann for the reasons given above. Hunt is not cited for, nor does it overcome the foregoing deficiencies of Westaby and Fleischmann. Thus, Hunt does not disclose or suggest a bandage comprising a sheet “having a plurality of discrete passageways overlying the wound.” Claim 63 depends from claim 55. Claim 55 is patentably distinguishable over Westaby and Fleischmann for the reasons given above. Hunt is not cited for, nor does it overcome the foregoing deficiencies of Westaby and Fleischmann. Thus, Hunt does not disclose or suggest a bandage comprising a sheet “having a plurality of discrete apertures overlying the wound.” Accordingly, applicants respectfully submit that claims 48 and 63 patentably distinguish over Westaby, Fleischmann and Hunt, and hence withdrawal of this 35 U.S.C. 103(a) rejection thereof is requested.

Reconsideration of the rejection of claims 55, 58, 59, 76, 78, and 79 as being unpatentable under 35 U.S.C. 103(a) over U.S. Pat. No. 4,953,565 to Tachibana et al. (“Tachibana”) in view of Fleischmann is requested. It is believed that independent claims 55 and 76, and dependent claims 58, 59, 78, and 79, patentably distinguish over Tachibana and Fleischmann for the reasons given below.

Regarding claim 55, the examiner asserts that Tachibana discloses “a device capable of treating a wound.” There is no mention whatsoever of “a device capable of treating a wound” in Tachibana. Instead, as indicated at col. 1, lines 11-15, Tachibana discloses an application kit “for external medicines, with which drugs can be administered into a human body through the skin thereof with high absorption efficiency *by the utilization of the function of ultrasonic oscillation.*” (*Italics provided.*) Tachibana does not disclose or suggest “a bandage configured to cover a wound and adhere to healthy skin adjacent the wound.” Instead, as shown in Fig. 1 and indicated at col. 2 lines 60-62, Tachibana discloses “a disk-like ceramic ultrasonic oscillator 10” situated in “a relatively flat container 11.” At col. 3, lines 12-14, Tachibana states that a layer 14 of the container 11 is “placed” on a patient’s skin.” Clearly, Tachibana’s layer 14 is not configured to “adhere to healthy skin adjacent the wound,” as required by claim 55.

Further, Tachibana does not disclose or suggest a “bandage comprising a first sheet overlying the wound and located adjacent to it” in combination with “the first sheet having a plurality of discrete apertures overlying the wound,” as required by claim 55. The examiner has correctly pointed out that the layer 14 placed on a patient’s skin “does not have any apertures.” Moreover, Tachibana does not disclose or suggest that “fluid from the fluid source” is “communicated to the wound through at least a first aperture of the plurality of discrete

apertures.” Since, as the examiner has acknowledged, the layer 14 placed on a patient’s skin “does not have any apertures,” the “fluid from the fluid source” cannot be “communicated to the wound through at least a first aperture of the plurality of discrete apertures.” Fleischmann is not cited for, nor does it overcome the foregoing deficiencies of Tachibana. Thus, as indicated above, Fleischmann does not disclose or suggest a bandage comprising a sheet “having a plurality of discrete apertures overlying the wound” as required by claim 55.

Regarding claim 76, as indicated above, Tachibana does not disclose or suggest a “bandage comprising a first sheet overlying a wound and located adjacent to it” in combination with “the first sheet having a plurality of discrete apertures overlying the wound.” Fleischmann is not cited for, nor does it overcome the foregoing deficiencies of Tachibana. Thus, as indicated above, Fleischmann does not disclose or suggest a bandage comprising a first sheet overlying a wound and located adjacent to it” in combination with “the first sheet having a plurality of discrete apertures overlying the wound” as required by claim 76. Accordingly, applicants respectfully submit that independent claims 55 and 76, and dependent claims 58, 59, 78, and 79, patentably distinguish over Tachibana and Fleischmann, and hence withdrawal of this 35 U.S.C. 103(a) rejection thereof is requested.

New claim 87 depends from claim 86. As indicated above, since the examiner has not rejected claim 86, claim 87 is believed to be allowable. New claim 88 depends from claim 45, and is therefore allowable for the reasons given above in support of claim 45. New claim 89 depends from claim 55, and is therefore allowable for the reasons given above in support of claim 55. New claim 90 depends from claim 66, and is therefore allowable for the reasons given above in support of claim 66.

In view of the foregoing amendment and supporting remarks, the subject application is now deemed to be in condition for allowance, and such action is respectfully requested. If the Examiner believes that a telephonic interview would expedite the allowance of this application, he is requested to contact the undersigned for a prompt resolution of any outstanding issues.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response, and

shortages and other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to file 7175-67612.

Respectfully submitted,
BARNES & THORNBURG



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